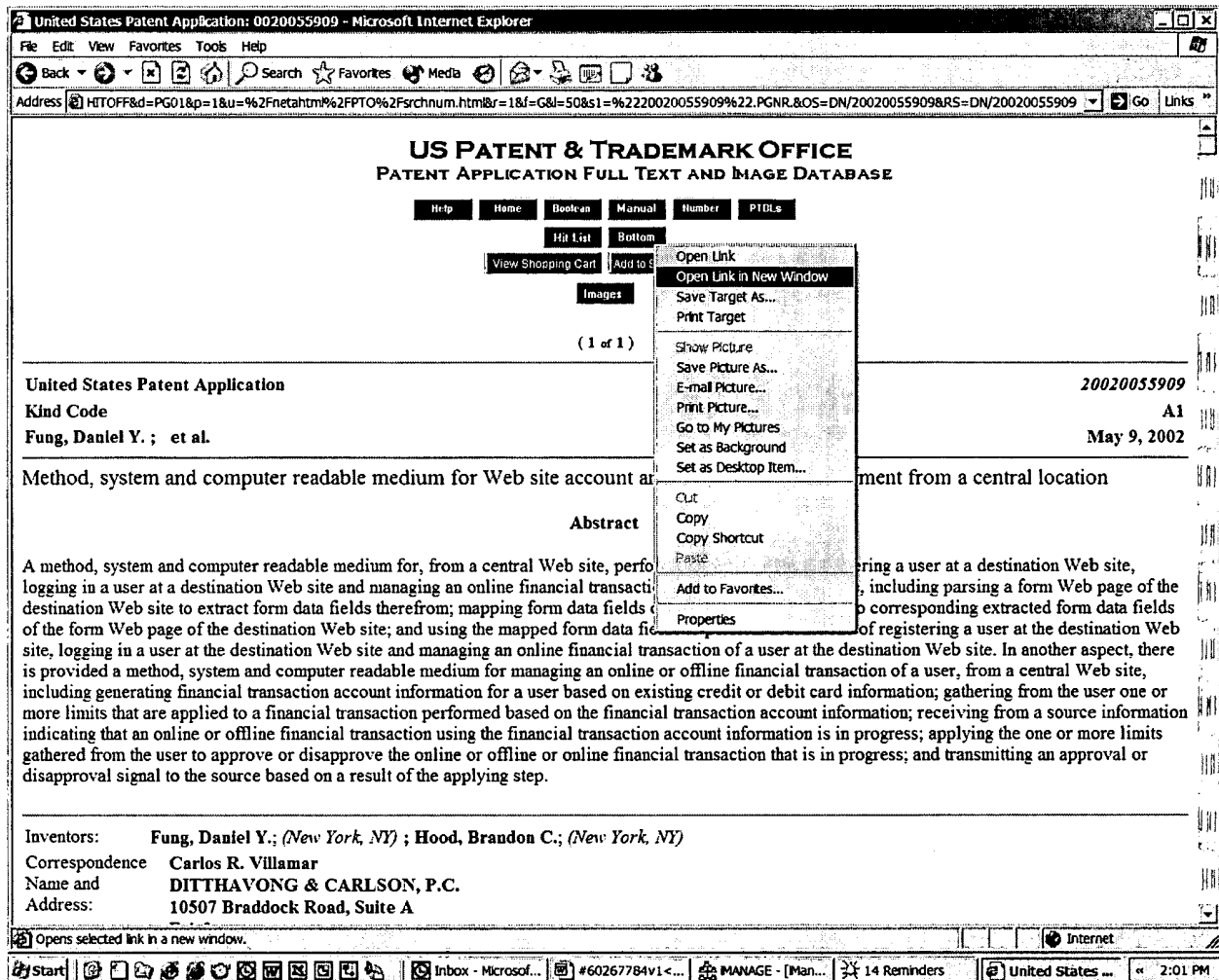


**REMARKS/ARGUMENTS**

**35 U.S.C. §112 Rejection - Priority**

Applicant's claim to the filing date benefit is rejected as not in compliance under 35 U.S.C. §112. The final Office Action presents a general definition for "pop-up window," which is consistent with the disclosure in the U.S. Patent Application No. 09/516,209 ("Parent Application"), but lacks the required specificity for the disclosed limitation. The Parent Application discusses use of a pop-up window on page 20, lines 18-20.

Taken in context, the Parent Application is referring to a pop-up window that displays web pages using an Internet browser. See Parent Application, page 19, line 23, through page 20, line 24. A whole industry has evolved around blocking pop-up windows when using a web browser. Indeed, the just released version of Internet Explorer™ provided in service pack 2 of Windows XP™ even includes a pop-up window blocker. Although Applicants believe that the term "pop-up window" is notoriously well known to any user of the world wide web, a thorough discussion of the term is provided.



Links in web pages can be manually opened in a new web browser window. This is accomplished by a right-click on the link that brings up a context-sensitive menu, which is shown in the sole figure. Then, the user can manually select to open the link in the same window (i.e., the first option on the context-sensitive menu) or in a new window (i.e., the second option in the context-sensitive menu). This process would be described as the user manually opening a new web browser window. This is the opposite situation as claimed, but provides context for an understanding of what automatically opening a new web browser means.

Well within the ordinary skill in the art, HTML programming language is used to design the web pages that are read by web browsers. When a link is embedded into a web page, the designer can either present the linked object in the same window or a new window. For

example, to load the object "patent.html" in the same window with a textual link called "Patent," the HTML command would be: <A HREF="patent.html" TARGET=\_top>Patent</A>. Alternatively, the object "patent.html" could be loaded in a new pop-up window using the command: <A HREF="patent.html" TARGET=\_blank>Patent</A>. With either of these commands, the link would appear in the text as "Patent" such that a user cannot which will happen before selecting the link with a click.

The user activates the link and either action could occur based upon how the HTML hosted on the server of the web page is coded. That is to say, the user cannot manually affect the opening of a new web browser window after activating the link if the HTML is coded to open a new window. Unless the user performs the manual steps with the context-sensitive menu before activation of the link, the user has no control over whether the linked information appears in the same window or a new window. The server of the web page receives the click and automatically decides (based upon the HTML) if a new web browser window is opened or not. That is to say, the server controls the "automatically opening a new web browser window for the customer." Application, claim 1, line 4.

Applicants believe use of the term "pop-up window" in the context of web browsing, fully supports the present claims. One of ordinary skill in the art knows that a pop-up web browser window involves automatically opening that window. Any interpretation to the contrary is believed unreasonable. Reconsideration is respectfully requested.

### **35 U.S.C. §103 Rejection**

The Office Action has rejected claims 1-7, 9-15 and 17-20 under 35 U.S.C. §103(a) as being unpatentable over the cited portions of U.S. Patent No. 5,899,980 to Wilf et al. (hereinafter "Wilf") in view of the cited portions of U.S. PreGrant Publication No. 2002/0055909 to Fung (hereinafter "Fung"). Further, claims 8 and 16 are also under 35 U.S.C. §103(a) as being unpatentable over Wilf in view of Fung and further in view of the cited portions of U.S. Patent No. 5,920,847 to Kolling et al. (hereinafter "Kolling"). Although, Fung is believed to not be prior art, this rejection has additional flaws. More specifically, Applicants believe a *prima facie* case of obviousness has not been properly set forth.

***Missing Limitations***

Fung is cited for the teaching of a pop-up window by citing page 4, lines 16-20, of that reference. Applicants concede that pop-up windows are known, but Fung uses a pop-up window in a completely different way. The present claims generally require opening a new window and presenting a transaction amount in that window. In Fung, the pop-up window is used as a part of the login process. See Fung, lines 16-20. Indeed, Fung teaches a pop-up window that does not include a transaction amount. Fung can only be relied upon to teach a pop-up window and not the claimed invention that requires a transaction amount be presented in that window.

***Motive to Combine***

Applicants believe motivation for the specific combination of elements in the cited references is lacking. As best understood by the Applicant, the motivation to combine arguments in the final Office Action follow a reasoning that if someone made the combination and/or substitution, the advantages would be self-evident. That is not the proper application of the test as the cited references themselves must teach or suggest the specific combination and/or substitution. To make the combination first can only be done by relying upon impermissible hindsight reconstruction using the claims as a template.

No cite is made to any reference for a motivation to combine in the final Office Action such the Applicants can only assume Official Notice is being relied upon for this proposition. Should this apparent Official Notice be maintained, an express showing of documentary proof of the motivation is requested as set forth in MPEP 2144.03.

**CONCLUSION**


In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is urged. Reconsideration of the claims in their current form is respectfully requested.

Appl. No. 09/991,379  
Amdt. dated 9/15/2004  
Amendment under 37 CFR 1.116 Expedited Procedure  
Examining Group 3628

PATENT

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,



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